

**REMARKS**

This amendment is intended as a full and complete response to the Action mailed February 28, 2003. In the Action, the Examiner notes that claims 1-5 are pending, of which claims 1-15 stand rejected. By this amendment, claims 1, 2, 4, 6, 9, 10, 12, and 13 are amended and claims 3, 5, 7, 8, 11, 14, and 15 continue unamended.

In view of both the amendments presented above and the following discussion, the applicants submit that none of the claims now pending in the application are indefinite, anticipated, or obvious under the respective provisions of 35 U.S.C. §112, §102, and §103. Thus, the applicants believe that all of these claims are now in allowable form.

It is to be understood that the applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to applicants' subject matter recited in the pending claims. Further, applicants are not acquiescing to the Examiner's statements as to the applicability of the prior art of record to the pending claims by filing the instant responsive amendments.

**Objections**

A. IN THE DRAWINGS:

The Examiner has objected to the drawings "because in Figure 3, there is no Element 128 as referenced by the specification. Further, the specification makes reference to Element 525 in Figure 5 which does not exist in the drawing." Formal drawings to be substituted for the informal drawings filed with the application are submitted herewith. In the formal drawings, applicants have added reference element 128 in Figure 3. Furthermore, reference element 525 has been deleted from page 19, line 19 of the specification. Therefore, the objection regarding FIG. 5 is now considered moot. Thus, the applicants respectfully request that the objections be withdrawn.

B. IN THE SPECIFICATION:

The Examiner has objected to the specification "because of the following informalities: in Figure 1, element 150 is not described in the specification. Similarly in Figure 3, Elements 320 and 330 are not described. On Page 7, reference is made to

Element '230' in Figure 1. Additionally on Page 14, Line 14, reference is made to Element '260.'"

The applicants have amended the specification to describe the elements referred to in the figures but not described in the specification. The applicants have also amended the specification, as suggested by the Examiner, to change "230" to --122-- on page 7, and "260" to --142-- on page 14.

Such amendments do not add any new subject matter to the application. Therefore, the applicants respectfully request that the objections be withdrawn.

#### **REJECTION OF CLAIMS UNDER 35 U.S.C. §112**

The Examiner has rejected claim 4 under 37 C.F.R. §112, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicants regard as the invention. Specifically, the Examiner stated that "claim 4 recites the limitation 'said advertisement content stream' in line 1. There is insufficient antecedent basis for this limitation in the claim." The applicants respectfully traverse the rejection.

The applicants have amended Claim 4 to change the limitation "advertisement content stream" to "secondary content."

As such, the applicants submit that Claim 4, as amended, is not indefinite and fully satisfies requirements under 35 U.S.C. §112 and is patentable thereunder. Therefore, the applicants respectfully request that the rejection be withdrawn.

#### **REJECTION OF CLAIMS UNDER 35 U.S.C. §102**

The Examiner has rejected claims 1-2, 4 and 6-8 under 35 U.S.C. §102 as being anticipated by International Application No. WO 98/48566 to Mankovitz (hereinafter Mankovitz). The applicants respectfully traverse the rejection.

The applicants have amended Claim 1 to recite additional features the applicants consider inventive. In particular, Claim 1, as amended, recites:

"In an interactive information distribution system including information provider equipment and information consumer equipment, a method for use in an information server comprising the steps of:

providing a primary video-on-demand (VOD) content stream to an information consumer; and in response to a

stop or pause command received from said information consumer, performing the steps of:

halting the providing of said primary VOD content stream to said information consumer; and

providing a secondary content to said information consumer." (emphasis added).

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984)(citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983)) (emphasis added). The Mankovitz reference fails to teach each and every element of the claimed invention, as arranged in the claim.

In particular, the Mankovitz reference discloses

"To enable a television viewer to access information about a television program that the viewer is watching, PRI is embedded in the VBI of the television carrying the television program. For example, the PRI may be textual information regarding actors and actresses in the show, advertisements of program-related merchandise, brief descriptions of the plot of future episodes of the television program, or any other text regarding the television program, or the PRI may be text representing web pages containing such information." (emphasis added) (See Mankovitz, pg. 5, lines 15-21).

By contrast, the applicants' invention, as amended in claim 1, includes a limitation of "providing a primary video-on-demand (VOD) content stream to an information consumer." It is well known in the art that video-on-demand content stream is completely different from broadcasting television programming, as disclosed by the Mankovitz reference. Therefore, since the Mankovitz reference fails to teach, or even suggest, providing a primary video-on-demand content stream to an information consumer, the Mankovitz reference fails to teach each and every element of the claimed invention as arranged in the claim.

As such, the applicants submit that independent claim 1, as amended, is not anticipated and fully satisfies the requirements under 35 U.S.C. §102 and is patentable thereunder. Furthermore, claims 2, 4, and 6-8 depend from independent claim 1 and recite additional features thereof. As such, and for at least the same reasons discussed above, the applicants submit that these dependent claims are not anticipated and fully

satisfy the requirements under 35 U.S.C. §102 and are patentable thereunder.

Therefore, the applicants respectfully request that the rejections be withdrawn.

### **REJECTION OF CLAIMS UNDER 35 U.S.C. §103**

#### **Claims 3, 5 and 9**

The Examiner rejected claims 3, 5 and 9 under 35 U.S.C. §103(a) as being unpatentable over Mankovitz in view of U.S. Patent No. 5,724,520 to Dedrick (hereinafter Dedrick). The rejection is respectfully traversed.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984) (emphasis added).

Claim 3 depends from independent claim 1 and recites additional features thereof. In particular, claim 3 when combined with independent claim 1 recites:

In an interactive information distribution system including information provider equipment and information consumer equipment, a method for use in an information server comprising the steps of:

providing a primary video-on-demand (VOD) content stream to an information consumer; and in response to a stop or pause command received from said information consumer, performing the steps of:

halting the providing of said primary VOD content stream to said information consumer; and

providing a secondary content to said information consumer;

wherein said secondary content provided to said information consumer is determined with respect to a demographic profile associated with said information consumer.

In particular, the Mankovitz reference teaches:

“To enable a television viewer to access information about a television program that the viewer is watching, PRI is embedded in the VBI of the television carrying the television program. For example, the PRI may be textual information regarding actors and actresses in the show, advertisements of program-related merchandise, brief descriptions of the plot of future episodes of the television program, or any other text regarding the television program, or the PRI may be text

representing web pages containing such information." (See Mankovitz, pg. 5, lines 15-21).

However, the Mankovitz reference fails to teach and suggest "providing a primary video-on-demand (VOD) content stream to an information consumer". Rather, the Mankovitz reference merely discloses broadcasting television programs and including content based on a personalized file of an end-user during vertical blanking. Therefore, the Mankovitz reference fails to teach or suggest the applicants' invention as a whole.

Furthermore, the Dedrick reference fails to bridge the substantial gap as between the Mankovitz reference and the applicants' invention. In particular, the Dedrick reference teaches collecting personal profiled data from input by an end-user, monitoring new client activity, and using the collected personalized data to customize electronic content to the end-user. (See Dedrick, Col. 8, lines 17-39). However, nowhere is there any teaching or suggestion in the Dedrick reference of "providing a primary video-on-demand (VOD) content stream to an information consumer."

Moreover, even if the two references could operably be combined, the combination would merely disclose sending customized electronic content to an end-user during the vertical blanking interval of a television carry a television program. This is completely different from the applicants' invention, since the applicants' invention provides a primary video-on-demand content stream to an information consumer, and in a response to a stop or pause command received from the information consumer, the primary VOD content stream is halted and a secondary content is then provided to the information consumer. Nowhere in the combined references is there any teaching or suggestion of providing a primary video-on-demand content stream, and a response to a stop or pause command received by the information consumer, halting the primary video-on-demand content stream, and then providing secondary content to the information consumer. Therefore, the combined references fail to teach the applicants' invention as a whole.

As such, the applicants submit that claim 3 is not obvious and fully satisfies the requirements under 35 U.S.C. §103 and is patentable thereunder. Furthermore, claims 5 and 9 also depend from independent claim 1 and recite similar features thereof. As such and at least for the same reasons discussed above, the applicants submit that these claims are also not obvious and fully satisfy the requirement under 35 U.S.C.

§103 and are patentable thereunder. Therefore, the applicants respectfully request that the rejections be withdrawn.

Claims 10-15

The Examiner has rejected claims 10-15 under 35 U.S.C. 103as being unpatentable over Dedrick in view of Mankovitz. The applicants' respectfully traverse the rejection.

The applicants have amended independent claim 10 to include additional features the applicants consider inventive. In particular, claim 10, as amended, recites:

In an interactive information distribution system including provider equipment and subscriber equipment, provider apparatus comprising:

a head end controller for interacting with subscriber equipment;

a video server, responsive to said head end controller for providing a primary video-on-demand (VOD) content streams;  
a transport processor, for communicating VOD content to said subscriber equipment via a distribution network; and

an advertisement manager, responsive to said head end controller for providing secondary content;

said head end controller, in response to a stop or pause command received from said subscriber equipment, causing said advertisement manager to provide said secondary content to said transport processor for communication to said subscriber equipment. (emphasis added).

As discussed above, since the Dedrick and the Mankovitz references fail to teach and suggest "providing a primary video-on-demand (VOD) content stream to an information consumer". Rather, the Mankovitz reference merely discloses broadcasting television programs and including content based on a personalized file of an end-user during vertical blanking. Therefore, the Mankovitz reference fails to teach or suggest the applicants' invention as a whole.

Furthermore, the Dedrick reference fails to bridge the substantial gap as between the Mankovitz reference and the applicants' invention. In particular, the Dedrick reference teaches collecting personal profiled data from input by an end-user yet monitoring new client activity, and using the collected personalized data to customize electronic content to the end-user. (See Dedrick, Col. 8, lines 17-39). However,

nowhere is there any teaching or suggestion in the Dedrick reference of "providing a primary video-on-demand (VOD) content stream to an information consumer."

Moreover, even if the two references could operably be combined, the combination would merely disclose sending customized electronic content to an end-user during the vertical blanking interval of a television carry a television program. This is completely different from the applicants' since the applicants' invention provides a primary video-on-demand content stream to an information consumer and a response to a stop or pause command received from the information consumer, the primary VOD content stream is halted and a secondary content is then provided to the information consumer. Nowhere in the combined references is there any teaching or suggestion of providing a primary video-on-demand content stream, and a response to a stop or pause command received by the information consumer halting the primary video-on-demand content stream and then providing secondary content to the information consumer. Therefore, the combined fail to teach the applicants' invention as a whole.

As such, the applicants submit that independent claim 10 is not obvious and fully satisfies the requirements under 35 U.S.C. §103 and is patentable thereunder. Furthermore, claims 11-15 depend from independent claim 10 and recite additional features thereof. As such and at least for the same reasons discussed above, the applicants submit that these dependent claims are also not obvious and fully satisfy the requirements of the 35 U.S.C. §103 and are patentable thereunder. Therefore, the applicants respectfully request that the rejections be withdrawn.

#### **PRIOR ART MADE OF RECORD BUT NOT RELIED UPON**

The references cited and not relied upon have been studied, and it is submitted that their disclosures are not sufficiently pertinent to the claimed invention to warrant a detailed statement of the manner in which the present claims distinguish patentably over such references.

#### **CONCLUSION**

Thus, the applicants submit that claims 1-15 are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Steven M. Hertzberg or Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

5/28/03

*E. Wall*

---

Eamon J. Wall, Attorney  
Reg. No. 39,414  
(732) 530-9404

Moser, Patterson & Sheridan, LLP  
Attorneys at Law  
595 Shrewsbury Avenue, Suite 100  
Shrewsbury, New Jersey 07702